

P. M.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Art Unit: 2155
)	
Lakshmi Arunachalam)	Examiner: H. Phillips
)	
Serial No. 09/863,704)	
)	
Filing Date: May 23, 2001)	
)	
Title: METHOD AND APPARATUS)	
FOR ENABLING REAL TIME)	
TRANSACTIONS ON A)	
NETWORK)	
)	

DUTY OF CANDOR DISCLOSURE UNDER 37. C.F.R §1.56

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Honorable Commissioner:

In accordance with 37 C.F.R. §1.56, please accept this Duty of Candor
Disclosure.

COMMENTS

Microsoft Corporation has recently filed a complaint CV 08 5149 in the United States Federal Court for the Northern District of California against the owner of several of the parent patents (applications) in this case. Microsoft has asked for a declaratory judgment of unenforceability based on alleged inequitable conduct against the present inventor in procuring the following parent patents: 5,778,178 (08/700,726), 6,212,556 (09/296,207) and 7,340,506 (09/792,323). All of these patents are priority applications

to the present case. This complaint has already been supplied in an Information Disclosure Statement in this case and is currently in the record.

Microsoft alleges that the inventor Ms. Lakshmi Arunachalam failed to disclose certain documents during the course of prosecution of these three patents. In particular, Microsoft alleges that the inventor did not disclose the following three documents: 1) SMI RFC-1155, "Structure and Identification of Management Information for TCP/IP Based Internets", published May 1990, 2) MIB II RFC-1213 "Structure and Identification of Management Information for TCP/IP Based Internets", published March 1991, and 3) SNMP RFC-1157, "A Simple Network Management Protocol (SNMP)", published May 1990. All three of these documents have already been supplied to the Patent Office in an Information Disclosure in the present case. However, the applicant did not know of the existence of these documents during initial prosecution.

Microsoft also alleges that the inventor not only knew of these documents, but copied portions of them into the specification of these patents.

Microsoft, in their complaint, presented the following table:

<u>RFC 1156 Excerpts</u>	<u>'178 Patent Excerpts</u>
Managed objects are accessed via <u>a virtual information store</u> , termed the Management Information Base or MIB. Objects in the MIB are defined using Abstract Syntax Notation One (ASN.1) [8] defined in the [Internet standard] SMI.	DOLSI(B)s are <u>virtual information stores optimized for networking</u>
In particular, <u>each object has a name, a syntax, and an encoding. The name is an object identifier, an administratively assigned name, which specifies an object type. The object type together with an object instance</u>	<u>Each object in the DOLSI(B) has a name, a syntax and an encoding. The name is an administratively assigned object ID specifying an object type. The object type together with the object instance serves to uniquely identify a specific instantiation of the object. The syntax of an object type defines the abstract data structure corresponding to that object type. Encoding</u>

serves to uniquely identify a specific instantiation of the object. For human convenience, we often use a textual string, termed the OBJECT DESCRIPTOR, to also refer to the object type.

The syntax of an object type defines the abstract data structure corresponding to that object type. The ASN.1 language is used for this purpose. However, the SMI [12] purposely restricts the ASN.1 constructs which may be used. These restrictions are explicitly made for simplicity.

The encoding of an object type is simply how that object type is represented using the object type's syntax. Implicitly tied to the notion of an object type's syntax and encoding is how the object type is represented when being transmitted on the network. The SMI specifies the use of the basic encoding rules of ASN.1 [9], subject to the additional requirements imposed by the SNMP.

of objects defines how the object is represented by the object type syntax while being transmitted over the network.

12. A method for enabling object routing on the World Wide Web, said method for enabling object routing comprising the steps of:

creating a virtual information store containing information entries and attributes;

....

15. The method claim 12 wherein said step of associating each of said information entries and said attributes with said object identity further includes the step of storing a name, a syntax and an encoding for each of said object identities.

16. The method in claim 15 wherein said name of said object identity specifies an object type.

The inventor admits that these documents were not disclosed to the Patent Office in the previous cases since she did not know of them, and that there is language in her specification that is similar to that contained in these documents. The inventor is not sure where the similar language appearing in her specification came from.

Microsoft also alleges that the inventor failed to notify the Patent Office about her PCT application No. PCT/US96/18165 published in 1997 as WO 97/18515 in the case of patent number 6,212,556 (09/296,556) filed April 21, 1999. Since the '556 patent application was a continuation-in-part, it contained new matter, and claims to new matter.

The inventor admits that her PCT application was published in 1997, more than one year before the filing date of the application for the '556 patent, and that the application for the '556 patent was a CIP and contained new matter. The inventor did not disclose the PCT application to the examiner. However, as Microsoft states in their complaint, the PCT application was almost identical to the original parent application U.S. Patent number 5,778,178 (08,700,634). This original US parent application was on file at the Patent Office and known to the examiner through the chain of priority claimed in the application for the '556 patent. Since the PCT application was almost identical to the original parent, it did not contain any of the new matter. Therefore, the inventor was therefore not required to disclose it to the examiner since it was cumulative. In any case, a copy of PCT/US96/18165 has been already been supplied in an information disclosure in the present case.

To the extent that the present examiner concludes that the material in RFCs 1155, 1213 and 1157 is relevant to the present case, further examination is invited by the inventor. However, it is the inventor's belief that these SNMP documents are not material to the present claims. The present claims are directed to real time transactions relating to web pages involving switching between multiple servers. The RFC documents simply do not discuss switching users between multiple servers presenting multiple web pages so that real time transactions can take place.

An example claim from the current case is claim 87:

Claim 87. A method of permitting an online transaction in real-time by a user with at least one computing device on the World Wide Web comprising the steps of:

presenting a first web page from a first server allowing a user to choose a transaction from a plurality of possible transactions;

presenting a second web page allowing said user to display said second web page on said computing device and to interactively enter into said transaction with a particular seller;

switching said user from said first server to a payment server remote from said first server allowing said user to interactively settle said transaction wherein said user communicates directly from a user device to said payment server;

allowing said user to communicate by electronic mail with said seller.

None of the three RFC documents mention anything about a web page.

None of them mention switching a user from a first server to a payment server.

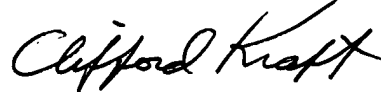
None of them mention electronic mail. Similar arguments apply to the other claims.

The Federal Circuit in the case Rohm & Haas Co. v. Crystal Chemical Co., 772 F.2d 1556, 220 U.S.P.Q. 289, 301 (Fed. Cir. 1983) has discussed what, if anything, can be done in the PTO during prosecution to cure or overcome possible previous misconduct. The formula given by the Federal Circuit is a) the applicant must expressly advise the PTO of the existence of a prior misrepresentation, stating specifically where it resides; b) the applicant must advise the PTO of the actual facts, if the prior misrepresentation was factual, and must indicate that further examination may be required, and c) the applicant must establish the patentability of the claimed subject matter.

Thus, following this formula: a)The inventor has disclosed that there is an

allegation of inequitable conduct in a parent case, and that the allegation names documents that were not submitted to the examiner at that time. The applicant admits that she did not submit these documents in the parent case since she did not know of them, and has submitted them in the present case. b) The inventor does not believe these documents to be material; however, to the extent the PTO feels they are material, the inventor invites the examiner to use these documents in the present case. c) The applicant has argued how the claims in the current case are patentable over these documents since these documents do not teach web pages, switching in real time between multiple servers and electronic mail.

Respectfully submitted



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 with sufficient postage.

On: FEB. 11, 2009

By: Clifford Kraft

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